

REMARKS on REVISIONS to CANCELLED CLAIM 7

New Claim 8

New claim 8 is virtually identical to cancelled claim 7 except for the following revisions:

1. In 8a, Applicant omitted the structural limitation of "advertiser process," as required by the Examiner,
2. In 8b, Applicant used a gerund phrasing, as is proper for a method claim,
3. In 8c, Applicant used a gerund phrasing, as is proper for a method claim, and Applicant moved a limitation stated in previous step 7f into 8c for greater clarity and for proper phrasing of a method claim,
4. In 8e, Applicant omitted the structural limitation of "recipient process," as required by the Examiner,
5. In the "whereby clause," Applicant made a stylistic change for clarity's sake.

These changes were made to correct the defects pointed out by the Examiner. Applicant, being pro se, had added the structural limitations to the cancelled claim for stylistic reasons, not realizing that the "structures" would create an invalid "mixed claim."

REBUTTAL ARGUMENTS AGAINST OBVIOUSNESS REJECTION

Applicant respectfully disagrees with Examiner's initial finding that the claimed invention is obvious in view of Examiner's combination of Goldhaber (U.S. No. 5,855,008), Walker (U.S. No. 6,086,477) and Vance (U.S. No. 6,267,672).

Applicant will discuss below why he objects to Examiner's case for obviousness. Applicant will use the MPEP as his guide in this discussion.

While Applicant will cite certain sections of the MPEP to argue his case, he reserves the right make additional arguments later, realizing that his discussion can be significantly expanded.

The Claimed Invention As a Whole Must Be Considered (MPEP 2141.02)

The MPEP states that, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious."

Applicant believes the claimed invention taken as a whole is highly novel and that combining aspects of three very different references – Goldhaber, Walker and Vance – is very non-obvious.

Goldhaber makes no mention of inspecting a payment recipient's qualifications for payment. One would have to make the leap that inspection of a recipient's adherence to a set of offer conditions is pivotal to paying for that recipient's attention. That leap is not obvious. Even if one made that leap, one would have to make a second leap that inspection should be probabilistic. That leap is not obvious. Then, if one made that leap, one would have to make a third leap that probabilistic inspection should be accomplished via expected value (EV) payment as the probabilistic selection method. That leap is very non-obvious. In sum, the collection of leaps as a whole seems extremely non-obvious.

This judgment is bolstered when one looks at the prior art references and sees that none suggests or implies combining the methods of the others, as is required by the MPEP.

The Prior Art Must Suggest the Desirability of the Claimed Invention (MPEP 2143.01)

The preamble to MPEP 2143 states, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings."

MPEP 2143.01 further states, "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of a person of ordinary skill in the art...*The level of skill in the art cannot be relied upon to provide the suggestion to combine references* [emphasis added]."

Vance cannot possibly suggest or imply combining "verification" with Goldhaber because Vance teaches a promotional game that has nothing to do with payment for attention to a message. Further, Vance's verification step is not the kind of inspection referred to in the claimed invention. Vance's verification does not have to do with a recipient matching a set of offer conditions, but is a simple code or password verification. Thus, it would not make sense in the context of Vance to combine this verification with Goldhaber's payment to targeted recipients.

Walker teaches a new kind "no-lose" of lottery ticket, one that might compete with a "scratcher" ticket sold by any lottery authority. Walker makes no mention whatsoever of payment for attention, and the invention is not in any way directed to paying for attention, so Walker does not suggest or imply a combination with Goldhaber.

Meanwhile, Goldhaber does not make any mention of inspection of a recipient's qualifications. One cannot find the terms *verify*, *verification*, *inspect*, *inspection*, *authenticate* or *authentication* anywhere in Goldhaber. One cannot find a discussion of these topics, and one cannot find an appreciation of the importance of verifying that a recipient matches a payment condition. Goldhaber shows no appreciation of "the nature of the problem to be solved" (to use the terminology of the MPEP, quoted above). Thus, Goldhaber cannot suggest or imply a combination with Vance, for the purpose of inspecting a recipient's qualifications, or a combination with Walker, for the purpose of probabilistic inspection.

Applicant further notes MPEP 2145 (page 2100-161), *Consideration of Applicant's Rebuttal Arguments*, Section X, *Arguing Improper Rationales for Combining References*, Sub-Section C, *Lack of Suggestions to Combine References*, "the Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references."

The Proposed Modification Cannot Change the Principle of Operation of a Reference (MPEP 2143.01)

If one were to make the modifications to Goldhaber that Examiner suggests, one would destroy a basic principle of operation of Goldhaber.

As Goldhaber states that Goldhaber is "based on four principles: attention, interest, sponsorship and privacy (col. 4, lines 30-35). Goldhaber devotes much space to describing the foundational importance of its privacy principle (col. 6 lines 28-67, col. 7 lines 1-22, and many more lines), which is operationalized via the use of protected profiles to channel ads to users.

Unlike Goldhaber, the claimed invention enables anyone to see an ad, no privacy being protected. A recipient's qualifications are probabilistically inspected AFTER the recipient has been exposed to an ad. The claimed invention lets users find ads and accept payment with no profiles necessary.

Goldhaber's brokerage fundamentally channels the ads.

If Goldhaber were to add the methods of the claimed invention then Goldhaber would have no need for one of its self-described "basic principles of operation," that is, privacy implemented via channeling ads according to protected profile data.

Thus, Goldhaber cannot suggest combining steps pulled from Walker and Vance to result in Applicant's claimed invention.

All Claim Limitations Must Be Taught or Suggested (MPEP 2143.03)

Applicant also notes that Examiner's suggested combination of three prior art references does not teach all the limitations of the claimed invention.

Consider two aspects of the claimed invention (see new claim 8 above):

1. "entering into the computer an advertiser offer that said recipients will be owed an amount of money...if they satisfy a set of at least one target audience characteristics"
2. "presenting an interface to the public for enabling anyone to access and accept said offer."

These two limiting conditions are not shown in the combination of Goldhaber + Walker + Vance because Goldhaber does not teach making payment offers available to the public. Goldhaber teaches channeling offers based on profiles.

The title of Goldhaber is *Attention Brokerage*. The brokerage *channels* ads and payments provided by advertisers only to those recipients who match the advertisers' criteria. The core of Goldhaber's invention is the entering of profile data by users and the providing of advertising and payment to these users based upon referencing their profiles:

- See Goldhaber's Claim 1, the sole independent claim, col. 21 lines 25-39
- See Abstract, lines 9-11
- See the Description Section, col. 6, line 28 to col. 7 line 45 and col. 13 lines 37-41
- See Drawings 7 and 11A that show profile blocks as a key part of the system.

Quoting from Goldhaber col. 5 lines 2- 10:

"In contrast, technology provided in accordance with the present invention permits the design of ads that are virtually custom-fitted to consumer preferences, thus ensuring that the ad messages will be welcomed and attentively viewed by the consumer. This ability to finely target (and customize) ads based on the interests of particular individual consumers maximizes efficiency and benefits both the advertisers and the consumers."

So, Goldhaber achieves efficiency by severely restricting who accesses a given ad and who receives a given payment. Thus, Goldhaber DOES NOT teach the presenting of an interface enabling anyone to access and accept a given payment offer for attention to a given ad message.

Walker teaches a special kind of lottery ticket and teaches nothing about an interface for accessing advertising. So Walker DOES NOT teach presenting an interface enabling anyone to access and accept a given payment offer for attention to a given ad message.

Vance teaches a special kind of promotional game and teaches nothing about an interface for accessing advertising. So Walker DOES NOT teach presenting an interface enabling anyone to access and accept a given payment offer for attention to a given ad message.

So, the combination of Goldhaber + Walker + Vance DOES NOT teach presenting an interface enabling anyone to access and accept a given payment offer for attention to a given ad message.

(See also, Applicant's previous response of 10/22/03 to Examiner's Office Action of 10/08/03.)

(If Goldhaber were implemented with no profiles and no channeling, where a payment offer is made to everyone, Goldhaber would lack targeting, rendering the hypothetical Goldhaber + Walker + Vance method empty of utility and very different from Applicant's claimed invention.)

(It is worth noting that Goldhaber's invention was well tested in the marketplace, as www.cybergold.com, funded with many millions of dollars of venture capital, and failed.)

CONCLUSION

As discussed in Applicant's previous responses to Examiner's Office Actions, and as required by 37 CFR 1.111c, the claimed invention has patentable novelty in view of the state of the art disclosed by the references cited.

The claimed invention produces the unexpected and useful result of enabling an advertiser to set target conditions of almost any kind and pay for the attention of recipients who match those conditions, *while eliminating the requirement that recipients create ad-channeling profiles of themselves*, thereby making the process user-friendly and efficient for recipients.

In light of the rebuttal arguments above, Applicant believes that a preponderance of the evidence shows that the claimed invention is not obvious in view of the prior art references cited in the Office Action of 12/29/03.

Applicant thanks the Examiner for consideration to this communication and for previous, constructive comments.

Respectfully submitted,

